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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/680,902

10/08/2003

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5490-000350

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EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

05/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/680,902

Applicant(s)

CUCKLER ET AL.

Examiner

James L. Swiger

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-9 and 11-16 is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/8/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments, see Pre-appeal conference request, filed 2/1/2007, with respect to claims 1-16, and 26-33 have been fully considered and are persuasive. The FINALITY of the action has been withdrawn.

Claim Objections

Claim 5 is objected to because of the following informalities: Line 11 of claim 5 reads "two sides holes" and it is suggested that it be changed to --two side holes--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Bastian et al. (US 5,769,854) in view of Barnes (US Patent 5,496,324). Bastian et al. disclose a bone cutting instrument comprising a guide (32) that is removably attachable

to bone and also having at least an axis, an opening (80), wherein it is capable of lateral adjustment relative to the opening and is capable of being laterally affixed while in multiple planes along the track/rotation point. The opening is also substantially box-shaped (see end of mill portion 70), has a driven end (92), as well as a cutting portion (60). The position is capable of being perpendicular. The apparatus also has affixation pins (54), to secure the cutting guide in place (Col. 3, lines 31-35). Bastian et al. further teach a bone-attachment flange (40) that is substantially parallel to the base with two guiding sides (see Fig. 5).

Bastian et al. disclose the claimed invention except for a mill that is specifically rotatable and slidable along the axis of the opening, and is considered to be able to move along a plurality of parallel planes. Barnes '324 disclose a milling apparatus that is rotatable and slidable along an opening (18) to facilitate the cutting of bone, making a more efficient and tailored cut. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of Bastian et al. and Barnes having at least a rotatable mill to better make a cut on the bone.

Claims 3-4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination Bastain et al. '854 and Barnes as applied to claim 2 above and in further view of Coleman (US 5,591,207). The combination of Bastian et al. and Barnes disclose the claimed invention except for a rod with a groove or truncated grooves to prevent lateral sliding, or a bore. Coleman discloses a device that teaches a rod (200) having truncated grooves (202) to allow the rod to be set at certain locations (see Col.

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6, lines 60-67), and also a bore (136) capable of use in securing purposes (121; Col. 6, lines 5-33). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of Bastian et al. and Barnes having at least a rod with truncated grooves and a bore in view of Coleman to aid in fixation and placement of the mill in use of the device.

Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bastian et al. '854 and Barnes as applied to claim 31 above and in further view of Dietz et al. (US 5,653,714). The combination of Bastian et al. and Barnes disclose the claimed invention except for the capability of the mill to slide laterally relative to the mill in either the first or second position. Dietz et al. teach a cutting guide that allows for lateral sliding along a rod (28) and see Fig. 1, that would be capable of interfacing with a mill portion (see Fig. 7) and in a first (Fig. 7) and second position (Fig. 8) that allows the device to be securely oriented in a multitude of positions, preventing the need for multiple cutting apparatuses. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bastian et al. and Barnes having at least the capability of lateral movement along a rod in view of Dietz et al. to allow for optimal orientation of the mill in relation to the cutting device.

Allowable Subject Matter

Claims 5-9 and 11-16 are allowed.

Response to Arguments

Applicant's arguments with respect to claims 1-16, and 26-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 4/30/07


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER